

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF : James Thomas Shiveley

FOR : RAPID EFFICIENT INFRARED CURING OF  
POWDER COATINGS/WET COATINGS AND FOR  
ULTRAVIOLET CURING OF COATINGS AS  
APPLIED TO LABORATORY AND PRODUCTION  
PROCESSING

SERIAL NO. : 09/851,720

FILED : May 9, 2001

LAST OFFICE ACTION : January 31, 2007

EXAMINER : Stephen Michael Gravini

GROUP ART UNIT : 3749

ATTORNEY DOCKET NO. : 30188.30008  
Customer #26781

Akron, Ohio 44311-4407

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**CERTIFICATE OF MAILING**

I hereby certify that this **PETITION TO WITHDRAW HOLDING OF  
ABANDONMENT 37 C.F.R. 1.181(a)** is being deposited with the United States Postal  
Service as first class mail in an envelope addressed to Mail Stop PETITION, Commissioner  
for Patents, P.O. Box 1450, Alexandria, VA 22313-01450, on the following date.

August 31, 2007  
Date

Debra L. Klapp  
Debra L. Klapp

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**PETITION TO WITHDRAW HOLDING OF ABANDONMENT 37 C.F.R. 1.181(a)**

Mail Stop PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant's attorney respectfully petitions the Commissioner for Patents to withdraw the holding of abandonment in the above-identified application under the provisions of 37 C.F.R. 1.181(a) on the ground that holding of abandonment was not in the interest of fairness.

FACTUAL BACKGROUND

The relevant history of this case is as follows. A final Office Action was mailed by the Examiner on July 7, 2006. A fully responsive amendment was mailed with a proper certificate of mailing dated January 8, 2007, which was the last day to timely file a response. A Notice of Non-compliant Amendment was mailed January 31, 2007. Since the amendment was responsive to a final rejection no new period for reply was given, so the application became abandoned immediately as of the mail date of the Notice.

ARGUMENT AGAINST THE HOLDING OF ABANDONMENT

The Examiner's grounds for rendering this application abandoned are entirely based on a superficial and inconsequential procedural defect. The response to the July 7 Office Action as filed is fully responsive in every substantive respect. Furthermore, the response includes all proper and necessary procedural documents required for prosecution including a Request for an Extension of Time to Respond, a Request for Continued Examination, and all required fees. The Applicant's sole error was to omit the text of several withdrawn claims, i.e. in the manner of a canceled claim. While this is improper, these claims had no bearing on the rejections and arguments at issue. The withdrawn claims were the subject of a restriction requirement and could not bear on prosecution outside the context of a divisional application. Furthermore, the text of the withdrawn claims was omitted in every preceding response to NON-FINAL office actions, but the Examiner did not raise the issue until doing so would cause the application to immediately go abandoned. The Examiner could have accepted the response as he had in each prior communication, and should have done so in the interest of fairness. If the Examiner wished to raise this issue, it could have been raised in any prior

non-final office action. Instead, he chose to raise the issue after final rejection, which necessarily and immediately resulted in abandonment of the application.

The Commissioner would probably agree that the purpose of requiring adherence to a standardized amendment format is to enable Examiners to quickly and expeditiously evaluate correspondence and determine the proper next step to take in prosecution. The amendment at issue serves this purpose. It adheres to the required format in every respect except the withdrawn claims. Significantly, the withdrawn claims were no longer at issue given the fact that they were the subject of a Restriction Requirement. In the interest of fairness Examiners have the discretion to accept a response that bears a superficial defect such as this. And, in the interest of fairness, we believe that the Examiner should have exercised his discretion to accept the response at issue.

RELIEF REQUESTED

Under MPEP 711.03(c)(I)(C)(1)(b)(3) for utility applications filed on or after May 29, 2000 the Examiner may accept a Petition for Withdrawal of a Holding of Abandonment, and if the Petition is deemed untimely the patent term may be reduced accordingly. If, as in this case, no Notice of Abandonment is received, the patent term is reduced by the number of days that the Applicant “failed to engage in reasonable efforts to conclude prosecution.” 37 CFR 1.704(a). Since the Applicant’s attorney took the present action as soon as he became aware of the abandoned status of the application, we submit that the patent term should not be reduced at all. However, if the Commissioner finds that the patent term should be adjusted, we believe that it should be reduced by no more than the period of abandonment minus the two months allowed for filing without being subject to patent term adjustment.

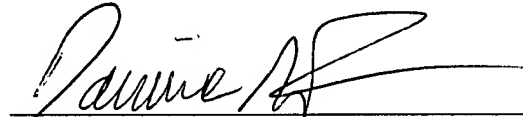
The Applicant believes that under 37 C.F.R. 1.181(a) no fees are required at this time. However, if fees are due, the Commissioner is hereby authorized to charge any additional necessary fees to Deposit Account No. 501210.

Respectfully submitted,

**BROUSE MCDOWELL**

8/31/2007  
Date

Telephone No.: (330) 535-5711  
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Dominic A. Frisina  
Reg. No. 55,807  
Customer #26781



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**CERTIFICATE OF MAILING**

I hereby certify that this **PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION UNDER THE PROVISIONS OF 37 C.F.R. 1.137(b)** is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop PETITION, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-01450, on the following date.

August 31, 2007  
Date

Debra L. Klapp  
Debra L. Klapp

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**PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION  
UNDER THE PROVISIONS OF 37 C.F.R. 1.137(b)**

Mail Stop PETITION  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant's attorney respectfully petitions the Commissioner for Patents to revive the above-identified application under the provisions of 37 C.F.R. 1.137(b) on the ground that the delay was unintentional. This petition is supported by the following statement.

A final Office Action was mailed by the Examiner on July 7, 2006. A fully responsive amendment was mailed with a proper certificate of mailing dated January 8, 2007, which was the last day to timely file a response. A Notice of Non-compliant Amendment was mailed January 31, 2007. Since the amendment was responsive to a final rejection no new period for reply was given, so the application became abandoned immediately as of the mail date of the Notice. However, no Notice of Abandonment has been provided up to and including the date of filing this Petition. Therefore, our docketing procedures did not detect the abandonment, and we continued to wait for a new office action. Recently, I took over prosecution of this case and upon my initial review of the case file, I noticed that abandonment must have resulted from the January 31 Notice of Non-compliant Amendment. As a result of my finding, I immediately undertook preparation and filing of this petition without further delay. Therefore, on the foregoing basis, the delay should be held unintentional, and the application should be revived for prosecution on the merits.

The Commissioner is hereby authorized to charge the petition fee in the sum required under 37 C.F.R. 1.17(m) in the amount of \$750 Account no. 501210. Furthermore, the Commissioner is hereby authorized to charge any additional necessary fees to Account No. 501210.

Respectfully submitted,

**BROUSE MCDOWELL**

8/31/2007  
Date

Dominic A. Frisina  
Dominic A. Frisina  
Reg. No. 55,807  
Customer #26781

Telephone No.: (330) 535-5711  
Fax No.: (330) 253-8601

Enclosures: Response to the July 7, 2006 Office Action,  
Request for Continued Examination,  
Petition for Withdrawal of the Holding of Abandonment

#690352  
DAF/dlk



## Instruction Sheet for RCEs

(not to be submitted to the USPTO)

### NOTES:

An RCE is not a new application, and filing an RCE will not result in an application being accorded a new filing date.

#### **Filing Qualifications:**

The application must be a utility or plant application filed on or after June 8, 1995. The application cannot be a provisional application, a utility or plant application filed before June 8, 1995, a design application, or a patent under reexamination. See 37 CFR 1.114(e).

#### **Filing Requirements:**

***Prosecution in the application must be closed.*** Prosecution is closed if the application is under appeal, or the last Office action is a final action, a notice of allowance, or an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex parte Quayle*). See 37 CFR 1.114(b).

***A submission and a fee are required at the time the RCE is filed.*** If reply to an Office action under 35 U.S.C. 132 is outstanding (e.g., the application is under final rejection), the submission must meet the reply requirements of 37 CFR 1.111. If there is no outstanding Office action, the submission can be an information disclosure statement, an amendment, new arguments, or new evidence. See 37 CFR 1.114(c). The submission may be a previously filed amendment (e.g., an amendment after final rejection).

### WARNINGS:

#### **Request for Suspension of Action:**

All RCE filing requirements must be met before suspension of action is granted. A request for a suspension of action under 37 CFR 1.103(c) does not satisfy the submission requirement and does not permit the filing of the required submission to be suspended.

#### **Improper RCE will NOT toll Any Time Period:**

***Before Appeal*** - If the RCE is improper (e.g., prosecution in the application is not closed or the submission or fee has not been filed) and the application is not under appeal, the time period set forth in the last Office action will continue to run and the application will be abandoned after the statutory time period has expired if a reply to the Office action is not timely filed. No additional time will be given to correct the improper RCE.

***Under Appeal*** - If the RCE is improper (e.g., the submission or the fee has not been filed) and the application is under appeal, the improper RCE is effective to withdraw the appeal. Withdrawal of the appeal results in the allowance or abandonment of the application depending on the status of the claims. If there are no allowed claims, the application is abandoned. If there is at least one allowed claim, the application will be passed to issue on the allowed claim(s). See MPEP 1215.01.

**See MPEP 706.07(h) for further information on the RCE practice.**





## Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.